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09/912,755	07/24/2001	J. Michael Milliorn	P02166US0	5349

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FULBRIGHT & JAWORSKI, LLP  
1301 MCKINNEY  
SUITE 5100  
HOUSTON, TX 77010-3095

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/912,755

Applicant(s)  
J. M. Milliorn

Examiner  
Mark Henderson

Art Unit  
3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 24, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “the label liner is a strip of label liner adapted to form a roll, the rolled strip of label liner holding a plurality of labels” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the edge" in line 7. There is insufficient antecedent basis for this limitation in the claim.

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*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirk (6,332,631).

Kirk discloses in Fig. 2 and 3, a label (20) comprising: a first section (34 and 36), a second section which forms a tab portion (left side of 38 in Fig. 3) , wherein each section has a first (Fig. 3) and second side (Fig. 2); an adhesive layer adapted to releasably adhere the label to a substrate surface/ liner (Col. 5, lines 25-29 and Col. 6, lines 5-10); wherein the first side of the second section does not include an adhesive layer (Col. 6, lines 1-10); and wherein the second side of the label (Fig. 2) has a surface adapted to accept printing of text.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 5, 7-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk.

Kirk discloses a label comprising all the elements as claimed in Claim 1, and as set forth above. However, Kirk does not disclose: the first section is in a particular shape; wherein the edge of the first section from which an edge of the second section extends converges with the edge of the second section to form a rounded edge between the first and second section; wherein the label, first and second sections are made of polypropylene; the text printed on the second side is related to food safety; wherein the second side surface accepts printing of color related to a color code system; wherein the adhesive is adapted to adhere to a substrate from a temperature range of about -10 degrees Celsius to 50 degrees Celsius.

In regards to **Claims 2 and 15**, it would have been an obvious matter of design choice to make the different portions of the first and second sections and portions of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within

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the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 4 and 5**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the label out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claims 7-11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 12 and 13**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an adhesive to adhere from any desirable temperature range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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6. Claims 3, 16-21, 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk in view of Sechet (5,472,756).

Kirk discloses a label comprising all the elements as claimed in Claim 1, and as set forth above. However, Kirk does not disclose: wherein an edge of the first section from which an edge of the second section extends converges with the edge of the second section to form a rounded edge between the first and second sections; wherein the label is fabricated; wherein the label is a plurality of labels; wherein the label liner is adapted to form a roll with labels;

Sechet discloses a label comprising a first section (1, 2 and 3) from which an edge (A) of a second section (5) extends converges with the edge of the second section (B) to form an edge between first and second sections; and wherein the second section is non adhesive (Col. 4, lines 50-60); wherein the text on the label is related to food safety; .

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kirk's label to include a first section having an edge which converges to an edge of the second section as taught by Sechet for the purpose of providing a means which to lift label section (1 and 2) from a substrate.

In regards to **Claims 3 and 16**, it would have been an obvious matter of design choice to make the different portions of the edge convergence of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.



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In regards to **Claim 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the label in any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claims 20 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate as many labels as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 24-28 and 30-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk in view of Sechet as applied to claims 17, 19 and 20 above, and further in view of Kojima (4,055,249).

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Kirk as modified by Sachet disclose a label comprising all the elements as claimed in Claims 17, 19 and 20 and as set forth above. However, Kirk and Sechet do not disclose a label liner adapted to form a roll which hold a plurality of labels.

Kojima discloses in Fig. 7, a label liner (3a) adapted to form a roll and hold a plurality of labels (1a).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kirk's and Sechet's label to include a liner adapted to form a roll and hold a plurality of labels for the purpose of providing a means which the labels can be placed on an efficient label placement operation such as a label administering machine.

### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Chigot, Gelsinger et al, Sullivan et al, Brown et al, Kelly, Jr., Sherwick et al, Sorensen et al, Hafele, Kaufmann, Small, Glenn, and Hamby et al disclose labels having tab portions.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 24, 2002



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700